

Election/Restriction

In accordance with the restriction and election of species requirements, Applicants provisionally elect, with traverse, Invention I, ultrasonic applicator Species IIIA. With respect to the other election of species requirement, Applicants elect, with traverse, the species shown in Figures 40-47.

In accordance with the Examiner's request, Applicants respectfully submit that claims 1-5, 7-10, 14-25, and 35-48 read on the elected Invention and Species. Furthermore, at least claim 1 is generic with respect to these requirements.

REMARKS

As an initial matter, claim 40 has been amended to correctly recite its dependency from claim 35.

The restriction requirement asserts that the Application contains claims directed towards the following patentably distinct Inventions: Invention I (claims 1-48) and Invention II (claims 49-51).

The Examiner further asserted that the Application contains the following patentably distinct species: Species I (figure 1); Species II (figure 4); Species III (figure 5); Species IV (figure 6); Species V (figure 7); Species VI (figure 9); Species VII (figure 10); Species VIII (figure 12); Species IX (figure 14); Species X (figure 16); Species XI (figure 18); Species XII (Figure 21); Species XIII (figures 22); Species XIV (figure 23); Species XV (figure 29); Species XVI (figure 30); Species XVII (Figures 31); Species XVIII (figures 22); Species XIX (figure 33); Species XX (figure 34); Species XXI (figure 35); Species XXII (Figures 36);) Species XXIII (figures 37); and Species XXIV (figure 38). The Examiner also stated that the ultrasonic applicator has three species: Species IA (figure 24); Species IIA (figure 25); Species IIIA (Figures 48).

Applicants have elected Invention I, Species IIIA, and the species shown in Figures 40-47. Additionally, Applicants have provided a listing of claims readable thereon. Applicants traverse the restriction and species requirements as the requirements are improper.

With respect to the restriction requirement, the Examiner provided the following invention identification:

- I. Claims 1-48 drawn to a suturing device; classified in class 606, subclass 232.
- II. Claims 49-51 drawn to suture securing method; classified in class 128, subclass 898.

Pursuant to 37 C.F.R. §§ 1.111 and 1.143, Applicants hereby traverse the Examiner's requirement for restriction and requests reconsideration therefore in view of the following remarks.

An Examiner's authority to require restriction is defined and limited by statute:

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions.

35 U.S.C. § 121, first sentence (emphasis added). The implementing regulations of the Patent and Trademark Office include the mandate that restriction is appropriate only in cases presenting inventions which are both independent and distinct, 37 C.F.R. §§1.141-142. Without a showing of independence and distinctness, a restriction requirement is unauthorized. In the present application, the claims which the Examiner has grouped separately are not "independent and distinct" so as to justify the restriction requirement.

The Examiner admits that Group I and II are related as an apparatus and product made, but alleges that the product of Group I can be used in a materially different process. However, the method of Group II specifically employs the product of Group I and is thus related. Thus, Applicants respectfully submit that these groups are different aspects of a single invention.

The courts have recognized that it is in the public interest to permit applicant to claim several aspects of their invention together in one application, as the applicant has done herein. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore describe in the manner required by 35 U.S.C. § 112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 456 F.2d 658, 666 117 U.S.P.Q. 250, 256 (CCPA 1973). This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

The Examiner also states that the inventions have acquired a separate status in the art as evidenced by the separate classification and recognized divergent subject matter and would require independent searches. Thus, the Examiner concludes that restriction for examination purposes is proper.

Reliance on the supposed classification of the groups of claims does not establish independence and distinctness. The classification system has no statutory recognition as evidence of whether inventions are independent and distinct. The classification system is instead an aid in finding and searching for patents.

The classification system is also an unreliable basis for requiring restriction between claims to the various aspects of applicant's unitary invention, because the system exhibits considerable overlap in technical definitions. In particular, the definitions of classes and subclasses in the classification system do not prevent the Examiner from basing patentability decisions, as to claims assigned to one group, on patent references found in the classes or subclass(es) with which he associated another group of claims.

Furthermore, the classification system is a poor basis for requiring restriction between related aspects of an invention because classifications and definitions change over time. Thus, a classification that might have seemed to support restriction at a given time could change, thereby casting a shadow over the propriety of the restriction requirement later on during the term of the patents issuing from parent and divisional applications. Indeed, classifications seem largely to change in response to considerations of administrative convenience, and often in response to nothing more than growth in the number of patents in a given class or subclass. These considerations have nothing to do with whether the subject matter of patents assigned to different classifications is "independent and distinct" as those terms are used in 35 U.S.C. § 121, which fact proves that basing restriction requirements on the classification system is improper.

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional purpose to promote and encourage the progress of science and the useful arts. Moreover, under the regulatory changes as a consequence of the General Agreement on Trade and Tariffs (GATT), applicant is required to conduct simultaneous prosecution, as here, requiring excessive filing costs or to otherwise compromise the term of related patent assets.

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. § 121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that § 121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle GmbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 288 U.S.P.Q. 837, 840 (Fed. Cir. 1986). In Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990), the court held that § 121 does not insulate a patentee from an allegation of "obviousness-type" double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these consideration indicate that the imposition of restriction requirement with inadequate authority can lead to situations in which an applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee's right and to serve the public interest in the legitimacy of issued patents, Applicants respectfully urge the Examiner not to require restriction in cases such as the present application wherein various aspects in a unitary invention are claimed.

Further and under the statute, an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)). MPEP § 803. If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. (Id.). Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions. MPEP § 808.

The Examiner identifies claims 1-48 as being drawn to a suturing device classified in class 606 for Surgery, subclass 232 for Suture retaining means. Applicants submit that each of the identified species would require a search of class 606, subclass 232, and that and there is no clear indication of separate future classification and field of search.

Therefore, the search and examination can be made without a serious burden and the Examiner must examine it on the merits, even though it may includes claims to different species. Accordingly, Applicants respectfully request reconsideration and withdrawal of the species requirement.

With respect to the election of species requirements, twenty-four species were identified. Although not specified, the species appear to be directed to the retainer for securing body tissue. In a second election of species requirement, three species of ultrasonic applicators were identified. Applicants elected species IIIA, figure 48. In light of this election, Applicants identify the species of retainer shown in figures 40-47 of the application, which was not identified by the Examiner.

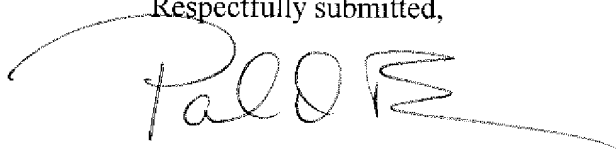
Conclusion

In light of the foregoing remarks, this application is now in condition for an examination on the merits, and early action is respectfully requested.

If any questions remain regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

No Fee is believed to be due. However, please charge any required fee (or credit overpayments) to the Deposit Account of the undersigned, Account No. 503410 (Docket No. 782-A03-024).

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Paul D. Bianco", with a long horizontal flourish extending to the right.

Paul D. Bianco, Reg. # 43,500

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